

Serial No. 09/124,231

Docket No.: 1046.1185

REMARKS**INTRODUCTION**

In accordance with the following, reconsideration of the allowability of the pending claims is respectfully requested.

Claims 1-19 are pending and under consideration.

REQUEST FOR NEW NON-FINAL OFFICE ACTION

The outstanding Office Action has re-opened prosecution to reject the pending claims based on a modification of Kanno, U.S. Patent No. 5,602,567, under the premise that it would have been obvious to modify an internal EPROM memory in the display of Kanno to store screen saver information.

In the previous Office Action, the proffered modification of Kanno was based on a secondary reference (Sparks et al., U.S. Patent No. 6,256,008) disclosing the use of screen savers, with the previous rejection before the previous Office Action being based on the secondary reference (Lundberg, U.S. Patent No. 5,738,527) disclosing a screen saver program stored in a storage system of a underlying computer.

Similarly, the outstanding rejection is based on the premise that it would have been obvious to modify Kanno to store a screen saver program in an internal memory of a display, with Kanno presently using only an EPROM for storing adjustments and parameter data for the display monitor. Specifically, the Office Action is relying on Yoshinobu, U.S. Patent No. 5,699,104, to disclose a screen saver program/information in a memory system within the underlying computer (Receiver 2A in FIG. 2 of Yoshinobu), and arguing that since Yoshinobu uses "V-RAM" to store that information it would have been obvious to implant the same into/instead of the EPROM of Kanno. As detailed in col. 7, lines 53-57, the V-RAM in Yoshinobu is for storing screen saver information for transmitting to a separate display.

It is respectfully submitted that the outstanding Office Action is primarily a repetition of the previous rejections and based on the same premise that it would have been obvious to modify Kanno to store screen saver information/program based on another reference storing the same in the underlying computer.

Accordingly, it is further respectfully submitted that the outstanding Office Action is improper for failing to address the previous responses presented in at least the Appeal Brief filed

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June 30, 2004. The substitution of a new reference does not obviate the applicants underlying arguments against modifying Kanno, which have been particularly set forth in the Appeal Brief.

As noted in at least MPEP 707.07(f), the Examiner is required to answer and address all traversals. This requirement is in addition to any repetition of a previously held position and is required to allow the applicant a chance to review the Examiner's position as to these arguments and to clarify the record for appeal.

Additionally and as further noted in MPEP 707.07(f), a failure of the Examiner to address the applicant's traversals can be deemed a failure to rebut these arguments so as to admit that the arguments have overcome the rejection. At the very least, the failure to address the applicant's traversals would render the Examiner's decision to again reject the claims arbitrary and capricious and invalid under the Administrative Procedures Act, 5 U.S.C. § 706, the standard under which such rejections are reviewed in view of Dickinson v. Zurko, 527 U.S. 150, 50 USPQ2d 1930 (1999).

As such, since the Examiner has not addressed the applicant's traversals presented in at least the Appeal Brief filed June 30, 2005, it is respectfully requested that the Examiner withdraw the outstanding Office Action and issue a new non-final Office Action addressing the same and the remarks included herein.

REJECTION UNDER 35 USC 103

Claims 1-19 stand rejected under 35 USC § 103 as being obvious over Kanno, in view of Yoshinobu. This rejection is respectfully traversed.

The non-obviousness of the modifying Kanno to include a screen saver in the disclosed EPROM, or the modification of the same to permit the same, is particularly addressed in the Appeal Brief filed June 30, 2004, the remarks of which are incorporated into the present response.

Again, it is respectfully submitted that there would not have been motivation for the proffered modification of Kanno, and the Office Action is lacking of any evidenced motivation for the same. The Examiner's opinion/conclusion is insufficient. There must be evidenced motivation in the record supporting the underlying motivation for modifying Kanno. Regardless of what other reference discloses, there still must be some reason for modifying Kanno to include the same. Similar to previous rejections, the Office Action has only rejected the claims based on

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the Examiner's believe that addition of a feature from the secondary reference would have been obviously modifiable or modified into Kanno.

However, as previously pointed out, this conclusion is improper.

The mere fact, that the prior art may be modified in the manner suggested in the Office Action does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F. 2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

Further, it is well settled that "the Board [and Examiner] cannot simply reach conclusions based on [their] own understanding of experience - or on [their] assessment of what would be basic knowledge or common sense. Rather the Board [and Examiner] must point to some concrete evidence in the record in support of these findings." In re Zurko, 258 F. 3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). (Emphasis added)

Thus, accordingly, a prima facie obviousness rejection requires evidenced motivation from something in the record that would lead one skilled in the art to combine the relevant teachings.

Again, it is respectfully submitted that the outstanding thus fails to present a prima facie obviousness case. The Office Action merely presents which feature Kanno fails to disclose, where that feature can be found (Yoshinobu), "because this would allow the display apparatus to protect its image data by using the screen saver function."

This recited motivation is only the opinion of the Examiner, based solely on the presently disclosed invention. Neither Kanno nor Yoshinobu discuss placing screen saver information in memory within a display, only the present application provides such motivation.

In addition, the fact that the proffered modification of Kanno "could" or "would" allow the proffered operation does not by itself support the conclusion of obviousness. There must be some motivation for the modification, not just that if it was performed the claimed invention would be disclosed.

In addition, the following is further noted.

Kanno recites: "based on the command received from an external device such as a computer via an interface (col. 2, line 34). According to this phrase, it is obvious that "monitor control CPU," in Kanno, operates based on a command from an external device. This is obvious from the other phrasings, such as "based on a received command" (col. 2, line 41), and "based on an inputted command" (col. 2, lines 48, 54, and 60). Moreover, this is obvious from other

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phrasings as "[w]hen the command requiring display monitor to read out the data is received from the CPU 3 of the computer 1" (col. 4, line 2)... "CPU 3 of the computer 1 sends a command... According to the command," (col. 4, line 24), "computer 1 sends a command... When the display monitor 2 receives the command," (col. 4, line 47), "the computer 1 sends to the display monitor 1, a command.... When the display monitor 2 receives the command," (col. 5, line 2), "computer 1 sends, to the display monitor 2, a command... When the display monitor 2 receives this command" (col. 5, line 12), "The CPU 3 of the computer 1 sends, to the display monitor 2, a command.... When the display monitor 2 receives this command" (col. 5, line 30), and "computer 1 sends, to the display 2, a command.... When the display monitor 2 receives this command" (col. 5, line 49).

As described above, in Kanno, the monitor control CPU, which operates according to a command from an external device, can not operate when the external device can not send a command (for example, when it's in a suspended state).

While on the other hand, "a display control unit" of the presently claimed invention is "operable to control the screen... irrespective of an operation mode of the main apparatus." In other words, the display control unit of the presently claimed invention operates regardless of a main apparatus's operation mode.

In addition, Yoshinobu describes only that screen saver data is stored in a memory, but further fails to describe the claimed display control unit of the presently claimed invention.

Lastly, without being exhaustive of previous arguments, it is respectfully submitted that it would not have been obvious to modify Kanno, as proffered.

Kanno would appear to work properly without such modifications, and that the memory of Kanno would appear to be adequate for storing only the video information for the display and not appear sufficient for storing screen saver application information. Similarly, Kanno would not appear to disclose computing capability within the display for accessing screen saver information and implementing the same, without substantial control from the computer. Thus, only the present application could provide support for such a modification of Kanno, and Kanno may not even be modifiable to perform the claimed operations.

Therefore, for at least the above, it is respectfully requested that this rejection of claims 1-19 be withdrawn and claims 1-19 be allowed.

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CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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I hereby certify that this correspondence is being trans-
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